UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/031,690 | 05/31/2002 | Frank Bongardt | H 4043 PCT/US | 8266 |

23657 7590 03/17/2006

COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

| EXAMINER | |
|---|---|
| TOOMER, CEPHIA D | |
| **ART UNIT** | **PAPER NUMBER** |
| 1714 | |

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/031,690 | BONGARDT ET AL. | |
| | Examiner | Art Unit | |
| | Cephia D. Toomer | 1714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *06 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *14-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

This Office action is in response to the amendment filed January 6, 2006 in which claims 14, 27 and 28 were amended.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 14-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/473,117. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition of the present invention is silent with respect to the components (d) and (e) of the copending application. However, the present claims are opened to the addition of these components .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 14-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenzel US 20030093941.

Wenzel teaches a fuel additive composition comprising a) one or more water-soluble alcohols having between 1 and 5 carbon atoms in an anhydrous state or as a 0.5-36 % aqueous solution one or more of b) one or more straight or branched chain alcohols having between 6-18 carbon atoms and c) one or more ethoxylated alcohols having between 12 and 18 carbon atoms where the ethylene oxide add-on is less than 5 moles and d) a source of nitrogen in an anhydrous state or as an aqueous solution (see abstract paragraph 223-229). The fuel may be any fossil fuel such as diesel (see paragraph 243). The composition may or may not contain water (see col. 28, examples and paragraphs 0440 & 0666). Wenzel teaches numerous fuel to additive ratios that encompass the claimed proportions, for example 99:1 to 50:50 (see paragraph 229).

In the examples, Wenzel discloses that the alcohols having 6-18 carbon atoms are present in the composition in an amount from 6-32 parts by volume (see paragraph 375, 377, 379, 381, etc) and the ethoxylated alcohol is present in an amount from 2-32 parts by volume (see paragraph 381, 383, 385). The other additives (a source of nitrogen) is present in the composition in an amount from 0.3-6 parts by volume (see

paragraph 375, 381, 379). Wenzel teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Wenzel differs from the claims in that he does not specially teach a composition wherein the $C_{12} - C_{24}$ branched alcohol is present. However, it would have been obvious to one of ordinary skill in the art to have employed such a compound because Wenzel teaches that one or more straight or branched-chain alcohol having 6 – 18 carbon atoms may be employed, and he exemplifies straight chain alcohols having 18 carbon atoms. The combination of these teachings clearly suggest that a branched chain of 18 carbon atoms may be included in the composition.

3. Claims 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over. Wenzel further in view of Boehmke (US 4,297,107).

Wenzel has been discussed above. Wenzel fails to teach or suggest the claimed corrosion inhibitor. However, Boehmke teaches that 0.5 –6% of ethoxylated carboxylic aid amides are employed in diesel fuel additives as emulsifiers and rust inhibitors (see abstract; col. 1, lines 23-31; col. 4 lines 28-35).

It would have been obvious to one of ordinary skill in the art to have employed the ethoxylated carboxylic acid amides in the fuel additive because Boehmke teaches that these compounds function as emulsifiers and rust inhibitor in fuel additives that contain alcohols and water and Wenzel teaches that too much may lead to corrosion (see Wenzel paragraph 359) .

4. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that there is no teaching or suggestion in Wenzel to omit the short chain alcohol and that Wenzel fails to disclose $C_{12}$-$C_{24}$ branched alcohols. Applicant argues that the branched chain alcohol and ethoxylated alcohols are optional ingredients for Wenzel whereas the emulsifier mixtures of claim 14 and 27 consist essentially of branched-chain fatty alcohol and ethoxylated fatty alcohol components.

In the abstract of Wenzel, it is disclosed that the additive composition comprises a) one or more water-soluble alcohols having between 1 and 5 carbon atoms in an anhydrous state or as a 0.5-36 % aqueous solution one or more of b) one or more straight or branched chain alcohols having between 6-18 carbon atoms and c) one or more ethoxylated alcohols having between 12 and 18 carbon atoms where the ethylene oxide add-on is less than 5 moles and d) a source of nitrogen in an anhydrous state or as an aqueous solution. Applicant's claim language "consisting essentially of" does not exclude the presence of the short chain alcohol. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976).

Applicant argues that Wenzel does not contain a single example of an additive composition containing both a branched $C_{12-24}$ alcohol and an ethoxylated $C_{8-24}$ alcohol.

It is well settled that a reference must be relied upon for all that it teaches and is not limited to specific working examples therein. In re Fracalossi, 215 USPQ 569 (CCPA 1982).

The examiner maintains that she has set forth a prima facie case of obviousness. Wenzel teaches in the abstract that the aqueous fuel contains a water soluble $C_{1-5}$ alcohol, and **one or more** of the following: **one or more** straight or **branched-chain alcohols having between 6-18 carbon atoms** and **one or more ethoxylated alcohols having 12-18 carbon atoms where the ethylene oxide add-ons is less than 5 moles**. Wenzel has set forth all of the required components. By his teaching of one of more of the components (b)-(e), Wenzel has clearly set forth what Applicant is claiming. The skilled artisan having Wenzel before him/her would not find it necessary to "try" to prepare the claimed composition. Wenzel discloses and suggests everything that Applicant is claiming.

Applicant argues that the addition of the ethoxylated carboxylic acid amides of Boehmke fails to cure the deficiencies of Wenzel and that there is no motivation to combine the two references.

The examiner respectfully disagrees. Wenzel desires a non-corrosive composition. Therefore, it would have been obvious to one of ordinary skill in the art to add a corrosion inhibitor, such as those taught by Boehmke, to the composition of Wenzel.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cephia D. Toomer
Primary Examiner
Art Unit 1714

10031690\031406